No. 05-

IN THE

Supreme Court of the United States

SUNBEAM PRODUCTS, INC.,

Petitioner,

v.

WING SHING PRODUCTS (BVI) LTD.,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1. Did the panel of the Court of Appeals for the Federal Circuit that decided this case err in analyzing the patent-in-suit on the basis of what "concept" it "contain[ed]," given relevant decisions of this Court and other panels of the Federal Circuit which establish that patents are not granted for concepts?

2. Did the Court of Appeals for the Federal Circuit improperly incorporate into the statutory framework of 35 U.S.C. § 116 a requirement that a joint inventor's contribution to a patent had to be "significant," and, accordingly, did the Federal Circuit err in concluding that a party's employees who collaborated on a patented design and suggested features that were claimed in the design were not joint inventors of the patent?

CORPORATE DISCLOSURE STATEMENT

Petitioner Sunbeam Products, Inc. (d/b/a Jarden Consumer Solutions) identifies the following parent corporations and any publicly held company that owns 10% or more of the corporation's stock: Jarden Corporation; American Household, Inc.; and Sunbeam American Holdings, Limited.

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Petitioner Sunbeam Products, Inc. hereby petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit entered on August 24, 2005.

OPINIONS BELOW

The opinion of the Court of Appeals for the Federal Circuit was not designated for publication by the Court but is set forth at 2005 U.S. App. LEXIS 18241 (Fed. Cir. Aug. 24, 2005) and in the Appendix ("App.") at 1a-17a. The opinions of the District and Bankruptcy Courts are reported at 311 B.R. 378 (S.D.N.Y. 2004) and 293 B.R. 586 (S.D.N.Y. 2003), respectively, and are set forth in the Appendix at App. 18a-117a.

STATEMENT OF JURISDICTION

The judgment of the Court of Appeals for the Federal Circuit was entered on August 24, 2005. This Court's jurisdiction is invoked under 28 U.S.C. § 1254(1).

The Bankruptcy Court had jurisdiction to hear this action pursuant to 28 U.S.C. § 157(b) and 28 U.S.C. § 1334(b) (App. 60a). The District Court had jurisdiction to hear Sunbeam's appeal pursuant to 28 U.S.C. § 158(a). The Court of Appeals for the Federal Circuit had jurisdiction to hear the appeal of the District Court's decision pursuant to 28 U.S.C. § 1295 (App. 5a-7a).

STATUTORY PROVISION INVOLVED

The statutory provision involved in this case is Section 116 of Title 35 of the United States Code. The first paragraph of Section 116, pertinent to the issues here, provides that:

> When an invention is made by two or more persons jointly, they shall apply for patent jointly and each make the required oath, except as otherwise provided in this title. Inventors may apply for a patent jointly even though (1) they did not physically work together or at the same time, (2) each did not make the same type or amount of contribution, or (3) each did not make a contribution to the subject matter of every claim of the patent.

STATEMENT OF THE CASE

This is a case between a U.S. company and a foreign-based supplier that collaborated on the development of a new product and a design patent related to that product. This case raises two significant issues concerning the joint inventorship of the design patent.

The first issue is whether the lower courts began their analyses of joint inventorship by incorrectly analyzing the scope of patent protection under the Patent Code. Both the District Court and Court of Appeals for the Federal Circuit ("Federal Circuit") started with a statement that a patented design must contain "an inventive concept" (App. 8a, 28a). But this is not the law. In accordance with well-settled Supreme Court precedent, patents are not granted for "concepts." *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972)

("concepts are not patentable"). *See also Parker v. Flook*, 437 U.S. 584, 589 (1978); *Westinghouse v. Boyden Power Brake Co.*, 170 U.S. 537, 555-56 (1898) (patents are not granted for "abstraction[s]"). Design patents are granted for the visual appearance and specific design characteristics created by what is illustrated in the patent drawings. 35 U.S.C. § 171; 37 C.F.R. § 1.153(a).

The lower courts' "concept" test also ignored the Federal Circuit's own prior authorities, cited in Sunbeam's briefs on appeal (*see, e.g.* Brief of Appellant at 43-45), but never discussed in the Federal Circuit's August 24, 2005 decision (App. 1a-17a). These prior authorities include *Durling v. Spectrum Furniture Co.*, 101 F.3d 100 (Fed. Cir. 1996) and *In re Harvey*, 12 F.3d 1061, 1064 (Fed. Cir. 1993). In *Durling*, 101 F.3d at 104, Judge Clevenger explained, "By focusing on the design concept of Durling's design rather than its visual appearance, the district court erred." In *In re Harvey*, 12 F.3d at 1064, Judge Michel explained that the Patent Office erred in considering "the prior art Harvey vase as a 'design concept' rather than for its specific design characteristics. Design patent references must be viewed in the latter fashion." *See also Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 949 (Fed. Cir. 1987) ("It is axiomatic under our precedent that one cannot obtain patent protection for an inventive concept or for the heart or 'essence' of an invention or for an achieved result.").

In this case, Judge Bryson, speaking for a panel that also included Judge Rader and Judge Linn, relied instead on another decision, *Hoop v. Hoop*, 279 F.3d 1004 (Fed. Cir. 2002) to support the use of "an inventive concept" test (App. 8a). However, *Hoop* is inapposite. *Hoop* is a case about whether the Hoop plaintiffs, on the one hand, or the Hoop